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EXAMINER

BLECK, CAROLYN M

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 09/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/638,650

Applicant(s)

CUTTLER ET AL.

Examiner

Carolyn M Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-15,17,25-31 and 47-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 6-15, 17, 25-31, and 47-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 10 July 2003. Claims 1-2, 6-15, 17, 25-31, and 47-66 are pending. Claims 3-5, 16, 18-24, and 32-46 have been cancelled. Claims 1, 10, 12-13, 15, 17, and 25-31 have been amended. Claims 47-68 are newly added.

Election/Restrictions

2. Applicant has elected Invention I. Applicant wishes that claim 16 be included in Invention II, and has canceled this claim.

Specification

3. The objection to the abstract is hereby withdrawn due to the amendment filed 10 July 2003.

Claim Objections

4. Claim 1 is objected to because of the following informalities: claim 1, line 5, "more than on life event" appears to be grammatically incorrect. Appropriate correction is requested. For purposes of applying art, this phrase is being interpreted as "more than one life event."

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5. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

6. Misnumbered claim 49-68 been renumbered as 48-66.

Claim Rejections - 35 USC § 112

7. The rejections of claims 17 and 25-31 are hereby withdrawn due to the amendment filed 10 July 2003.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 6, 49-50, and 56-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 6, line 1, "the method of claim 5" lacks proper antecedent basis. For purposes of applying prior art, "the method" is assumed to be dependent on claim 1. It is noted that claim 5 has been cancelled, and therefore claim 6 can no longer depend on claim 5.

As per claim 49, line 1, "the computer readable medium of claim 49" lacks proper antecedent basis. For purposes of applying prior art, "the computer readable medium" is assumed to be dependent on claim 48.

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As per claim 50, line 1, "the computer readable medium of claim 50" lacks proper antecedent basis. For purposes of applying prior art, "the computer readable medium" is assumed to be dependent on claim 49.

As per claim 56, line 1, "the computer-based system of claim..." lacks proper antecedent basis. It is noted that claim 56 does not depend on any claim. Therefore, for purposes of applying prior art, "the computer-based system of claim..." is assumed to be dependent on claim 52.

As per claim 57, line 1, "the computer-based system of claim 57" lacks proper antecedent basis. For purposes of applying prior art, "the computer-based system of claim 57" is assumed to be dependent on claim 56.

As per claim 58, line 1, "the computer-based system of claim 58" lacks proper antecedent basis. For purposes of applying prior art, "the computer-based system of claim 58" is assumed to be dependent on claim 57.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-2, 6-15, 17, 25-31, and 47-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonnstetter et al. (5,551,880) in view of Peters et al.

(5,893,098) and Sarchione et al. (Sarchione, Charles D., Michael J. Cuttler, Paul M.

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Muchinsky, and Rosemary O. Nelson-Gray, "Prediction of Dysfunctional Job Behaviors Among Law Enforcement Officers", *Journal of Applied Psychology*, Vol. 83, No. 6, pp. 904-912, 1998), for substantially the same reasons given the previous Office Action (see paper number 3). Further reasons appear below.

(A) As per claim 1, Bonnstetter discloses a method using a computer for predicting the success of an individual for a particular job using measured behavioral and values characteristics of the individual to avoid potentially biasing factors and to have a consistent expert system to allow evaluation of individuals (col. 1 lines 10-15, col. 4 line 63 to col. 5 line 2) comprising:

(a) presenting to the individual selected questions related to behavior and value characteristics relevant to the job (col. 26 lines 37-41);

(b) keying in responses to a computer for the selected questions and storing the answers on a computer disc in a computer (col. 4 line 63 to col. 5 line 2, col. 5 lines 29-42, and col. 6 lines 31-36);

(c) identifying specific factors required to be successful for a particular job at a particular company (col. 2 lines 36-40); and

(d) analyzing and predicting the individuals success for a particular job (col. 2 lines 13-37 and col. 28 lines 11-15).

Bonnstetter fails to expressly disclose storing the responses in a computer database and presenting stem questions and then revealing branch questions based on the stem questions.

Peters includes obtaining and collating information from a plurality of computer users by asking questions using a survey, wherein the information obtained is added and stored in a database, wherein the survey document includes branched to questions linked to another question or questions such that the branched-to question or questions will only be required to be answered by a respondent user if the respondent user gives a predetermined answer(s) to the question or series of questions to which the branched-to question is linked, wherein the survey document is present to the respondent user as a plurality of screens (where there are a plurality of questions), each screen asking one question and where the screen presenting a branched-to question will not be presented by the display to the remote user unless, he makes one or more predetermined answers to a previous question or questions (col. 1 lines 10-16, col. 3 line 47 to col. 6 line 44, and col. 115 lines 1-23).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to include the aforementioned components of Peters within the method of Bonnstetter with the motivation of reducing the amount of time to answer a survey by displaying only questions which are relevant to the user (Peters; col. 6 lines 19-27), reducing the amount of information received from a user (Peters; col. 1 lines 39-49), therefore reducing the cost and amount of storage needed for the responses, and increasing the accuracy of a prediction of an individuals success for a particular job (Bonnstetter; col. 1 lines 33-36 and col. 2 lines 13-22).

Bonnstetter fails to expressly disclose including questions related to life history information, wherein the life history information comprises more than one life event. In

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addition, Bonnstetter fails to expressly disclose the responses being relevant to predicting a predefined negative outcome for the applicant. However, Bonnstetter includes presenting to the individual selected questions related to behavior and value characteristics relevant to the job (Fig. 7A-7L, col. 26 lines 37-41).

Sarchione includes using personality and life history information to predict dysfunctional job behavior (reads on "predefined negative outcome") in the law enforcement occupation, wherein the dysfunctional job behaviors encompass a wide variety of undesirable actions such as absence, theft, and drug use, sexual misconduct, insubordination, and inappropriate verbal conduct toward the public (reads on "predefined negative outcome"), wherein the life history information was obtained from personal history questionnaires, a structured interview, and/or a background investigation report and including information related to work history, criminal history, and drug use history (reads on "life history information comprises more than one life event"), and wherein life history indices were predictive of job behavior as individuals who engaged in behaviors such as marijuana use, military court martial, and conviction for driving under the influence of alcohol (reads on "negative indicator" and "critical item") had a much higher probability of subsequent disciplinary problems (reads on "predefined negative outcome") as law enforcement officers than their counterparts who did not engage in such behaviors (page 905 col. 1 par. 2 and col. 2 par. 1-2; page 906 col. 1 par. 1 and col. 2 par. 2-4; Table 1 page 907; page 910 col. 1 all; page 911 col. 1 all).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to include the aforementioned components of Sarchione within the method of Bonnstetter with the motivation of increasing the accuracy of a prediction of an individuals success for a particular job (Bonnstetter; col. 1 lines 33-36 and col. 2 lines 13-22) and of accurately forecasting dysfunctional job behaviors which have high public visibility and produce high organization scrutiny – such as that of law enforcement officers, therefore reducing the occurrences of these behaviors and reducing public outrage and rebuke (Sarchione; page 905, col. 2, second full paragraph).

(B) Claim 2 repeats the same limitations as claim 1, and is therefore rejected for the same reasons given above in claim 1, and incorporated herein.

(C) As per claims 6 and 8-9, Sarchione includes deriving classes of dysfunctional job behaviors (reads on “negative outcome”) and using the classes to predict the probability of subsequent disciplinary problems (reads on “predefined outcome”) as a law enforcement officers than counterparts who did not engage in such behaviors (page 905 col. 1 par. 2 and col. 2 par. 1-2; page 906 col. 1 par. 1 and col. 2 par. 2-4; Table 1 page 907; page 910 col. 1 all; page 911 col. 1 all), wherein the classes include absence (reads on “performance deficiency”), theft, drug use, sexual misconduct, insubordination, inappropriate verbal conduct toward the public, disciplinary problems (reads on “objective”) (page 905 col. 2 par 1-2; page 906 col. 1 par. 3 and col. 2 par. 1-

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2). The motivation for combining Sarchione within Bonnstetter is given above in the rejection of claim 1, and incorporated herein.

(D) As per claim 7, Bonnstetter, Peters, and Sarchione fail to expressly disclose the outcome including failure to complete training. However, it is respectfully submitted that when evaluating an applicant for a job, an employer typically takes into consideration whether or not an applicant would be able to complete the required training based on the applicant's background, and the skilled artisan would have found it an obvious modification to include an outcome of failure to complete training within the method taught collectively by Bonnstetter, Peters, and Sarchione with the motivation of accurately matching an employee with a particular job and accurately predicting the success of persons for defined job positions (Bonnstetter; col. 1 lines 15-63), thus increasing job retention and decreasing training costs by ensuring people remain with the employer reducing the need to train new employees.

(E) As per claim 10, Peters includes allowing a user to input text in response to a question or a branched to question (reads on "stem question") (col. 4 lines 20-25 and col. 6 lines 51-57). As per the recitation of "descriptive information," it is noted that Peter's ability to enter textual information is considered to be a form of "descriptive information." The motivation being to allow complicated text answers to be entered by a user (Peters; col. 6 lines 51-57).

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(F) Claims 11-13 repeat the same limitations as claim 1, and are therefore rejected for the same reasons given for claim 1, and incorporated herein.

(G) As per claim 14, Bonnstetter, Peters, and Sarchione fail to expressly disclose the stem question response being unable to be altered by the applicant after completion of the question collection. It is respectfully submitted that typically when asking questions related to employment using a computer, the system prevents a user from returning to change answers to previous questions, and the skilled artisan would have found including the feature of preventing the altering of previously answered questions within the method taught collectively by Bonnstetter, Peters, and Sarchione with the motivation of receiving answers to questions accurately from applicants (Bonnstetter; col. 1 lines 17-25) and preventing tampering with responses to survey questions.

(H) Claims 15, 17, 25-31, and 47-51 repeat the subject matter of method claims 1-2, 6-10, and 12, respectively, as a computer readable medium comprised of software for instructing a computer rather than as a series of steps. As the underlying processes of claims 1-2, 6-10, and 12 have been shown to be fully disclosed by the collective teachings of Peters, Bonnstetter, and Sarchione in the above rejections of claims 1-2, 6-10, and 12, it is readily apparent that the software on a computer (col. 4 line 63 to col. 5 line 2 and col. 19 lines 40-47) disclosed collectively by Peters, Bonnstetter, and Sarchione includes the software to perform these steps. As such, these limitations are

rejected for the same reasons given above for method claims 1-2, 6-10, and 12, and incorporated herein.

(I) As per claims 26-27, Sarchione includes deriving classes of dysfunctional job behaviors (reads on "negative outcome") and using the classes to predict the probability of subsequent disciplinary problems (reads on "predefined outcome") as a law enforcement officers than counterparts who did not engage in such behaviors (page 905 col. 1 par. 2 and col. 2 par. 1-2; page 906 col. 1 par. 1 and col. 2 par. 2-4; Table 1 page 907; page 910 col. 1 all; page 911 col. 1 all), wherein the classes include absence (reads on "performance deficiency"), theft, drug use, sexual misconduct, insubordination, inappropriate verbal conduct toward the public, disciplinary problems (reads on "objective") (page 905 col. 2 par 1-2; page 906 col. 1 par. 3 and col. 2 par. 1-2). The motivation for combining Sarchione within Bonnstetter is given above in the rejection of claims 1 and 15, and incorporated herein.

(J) Claims 48-51 repeat the subject matter of claims 11-14, and are therefore rejected for the same reasons given for those claims, and incorporated herein.

(K) System claim 52 differs from method claim 1 by recited apparatus elements, namely a user interface and computer processor, rather than a series of steps. As per these elements, Bonnstetter discloses:

(a) a computer screen for keying in information to the computer (col. 4 line 63 to col. 5 line 21); and

(b) computer software for processing (see Figure 1 and col. 4 line 63 to col. 5 line 21).

The remainder of claim 52 repeats the same limitations as claim 1, and is therefore rejected for the same reasons given for claim 1, and incorporated herein.

(L) Claims 53-66 repeat the same limitations as claims 1-2, 6-9, and 10-14, and are therefore rejected for the same reasons given for those claims, and incorporated herein.

(M) Claims 55-56 repeat the same limitations as claims 26-27, and are therefore rejected for the same reasons given for those claims, and incorporated herein.

Response to Arguments

11. Applicant's arguments filed 10 July 2003 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear in the response filed 10 July 2003.

(A) At page 9 of the 10 July 2003 response, Applicant argues that the courts have repeatedly held that if a teaching or suggestion in the primary reference for the need is absent, then arbitrarily modifying the primary reference or combining of references is

improper. In particular, Applicant argues that the combination of the applied references is improper.

In response, the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that she has at least satisfied the burden of presenting a *prima facie* case of obviousness, since she has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see paper number 3). Note, for example, the motivations explicitly stated at the last full paragraph of page 5 of the present Office Action (i.e., reducing the amount of time to answer a survey by displaying only questions which are relevant to the user (Peters; col. 6 lines 19-27), reducing the amount of information received from a user (Peters; col. 1 lines 39-49), therefore reducing the cost and amount of storage needed for the responses, and increasing the accuracy of a prediction of an individuals success for a particular job (Bonnstetter; col. 1 lines 33-36 and col. 2 lines 13-22)") and at the first paragraph of page 7 of the present Office Action ("increasing the accuracy of a prediction of an individuals success for a particular job (Bonnstetter; col. 1 lines 33-36 and col. 2 lines 13-22) and of accurately forecasting dysfunctional job behaviors which have high public

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visibility and produce high organization scrutiny – such as that of law enforcement officers, therefore reducing the occurrences of these behaviors and reducing public outrage and rebuke (Sarchione; page 905, col. 2, second full paragraph)"). Moreover, in the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specifically support that particular motivation and/or an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

In response to Applicant's argument that the Examiner has ignored the mandate of the modern case law which clearly and explicitly hold that in order for the references to be combined, the references must explicitly teach or suggest a need for the modification, the Examiner respectfully submits that Applicant ignores case law regarding combinations of references within the level of ordinary skill in the art. For example, the Court in *In re Fritch* stated "[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant

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teachings of the references. [emphasis added]" *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Each applied reference does not expressly suggest combination with the other respective references; however, the Examiner has shown that motivation for combining the references existed in the prior art. The "modification" referred to in *In re Fritch* involves extensive changes to the primary references. Such is not the case in the present combinations, where all modifications proposed by the Examiner are specifically taught by the references and that knowledge generally available to one of ordinary skill in the art. Therefore, the combination of references is proper and the rejection maintained.

Furthermore, the Examiner respectfully submits that Bonnstetter's disclosure of a questionnaire for determining whether a person will be successful at a job, wherein the questionnaire determines whether a person will follow policy while on the job, wherein a scale is used in a report, wherein the report has a 1-10 scale, wherein 10 indicates perfect for a particular factor such as will a person follow policy (Fig. 7L, col. 2 lines 34-41, col. 9 lines 9-56). It is the position of the Examiner that based on the knowledge of ordinary skill in the art, the skilled artisan would understand that a score of zero would mean a potential job applicant would not be likely to follow policy on a job (i.e., failure). Therefore, it is respectfully submitted that Bonnstetter suggests predicting success or "failure", and thus the combination of Bonnstetter with Peters and Sarchione is proper.

In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be

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motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves.

References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

Further, according to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference

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relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

As such, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner both in the present Office Action as well as the prior Office Action, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

As such, it is respectfully submitted that Applicant appears to view the applied references, separately and in a vacuum, without considering the knowledge of average skill in the art.

(B) At pages 10-11 of the 10 July 2003 response, Applicant argues that the combination of the applied references is improper because the primary reference (Bonnstetter et al. (5,551,880)) teaches away from the present invention and from the modification applied in the rejection (i.e., the combination with Peters et al. and Sarchione et al.) Further, Applicant argues each of the references individually.

In response to Applicant's assertions that the Bonnstetter, Peters, and Sarchione combination is improper, and that the Bonnstetter reference teaches away from the Applicant's invention, it is noted that the passages upon which Applicant relies, namely col. 1 lines 26-31, are part of the "Background of the Invention" information and do not reflect the teachings disclosed by Bonnstetter throughout the reference as a whole. In their proper context, Bonnstetter states *"Information regarding prior experience, training, and education of an individual many times is important in evaluating the potential of a person for a particular job. However, it has been found this alone also is not generally conducive to a highly accurate predication rate for matching an employee with a particular job."* It is respectfully submitted that Bonnstetter recites that prior experience, training, and education alone are not generally conducive to matching an employee with a job, and Bonnstetter does not expressly disclose in this passage that prior experience, training, and education cannot be used to match an employee with a job. These passages, in their proper context, have been provided to identify problems that existed regarding matching employees with jobs at the time of the Bonnstetter invention. Simply stated, these passages describe long-felt needs within the art that Bonnstetter intended to address with the disclosed invention, and are not a description of the Bonnstetter invention, *per se*. In addition, the courts have held that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments. In re *Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply

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because it has been described as somewhat inferior to some other product for the same use.” In re *Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994)

The Applicant appears to view the references separately and in a vacuum, without considering the knowledge of average skill in the art, and further fails to consider the teaching and suggestions of the Bonnstetter reference, as detailed in the previous Office Action (paper number 3) and in the present Office Action. Contrary to the Applicant's assertion that the reference teaches away from the Applicant's invention, the Bonnstetter reference suggests that a principle purpose of the invention is to fulfill the need for "... a method which allows an employer to identify employees who are masking their natural behavior in their job, who are unmotivated, or who may be considering a career change or employment with another organization" (Bonnstetter; col. 2 lines 52-57). Based on the level of ordinary skill in the art, it is noted that identifying an employee who is unmotivated in a job suggests identifying a person who may not succeed (or would fail) at a particular job. Furthermore, the Examiner respectfully submits that Bonnstetter's disclosure of a questionnaire for determining whether a person will be successful at a job, wherein the questionnaire determines whether a person will follow policy while on the job, wherein a scale is used in a report, wherein the report has a 1-10 scale, wherein 10 indicates perfect for a particular factor such as will a person follow policy (Fig. 7L, col. 2 lines 34-41, col. 9 lines 9-56). It is the position of the Examiner that based on the knowledge of ordinary skill in the art, the skilled artisan would understand that a score of zero would mean a potential job applicant would not be likely to follow policy on a job (i.e., failure). Therefore, it is

respectfully submitted that Bonnstetter suggests predicting success or "failure", and thus the combination of Bonnstetter with Peters and Sarchione is proper.

(C) At page 10 of the 10 July 2003 response, Applicant argues that the applied reference of Bonnstetter is the opposite of Applicant's invention, which acquires life history information that is relevant to predicting a predefined negative outcome, or event, e.g., failure to complete training, etc. Further, Applicant argues that the word "event", "outcome", and "occurrence" is never used by Bonnstetter. In addition, the Applicant argues that the Examiner improperly equates Applicant's life history information with Bonnstetter's behavioral and value characteristics.

In response, the Applicant appears to view the applied references separately and in a vacuum, without considering the knowledge of average skill in the art, and further fails to consider the teaching and suggestions of the Bonnstetter, Peters, and Sarchione references collectively, as detailed in the previous Office Action (paper number 3) and in the present Office Action.

In response to Applicant's assertion that the applied reference of Bonnstetter is the opposite of Applicant's invention, which acquires life history information that is relevant to predicting a predefined negative outcome, or event, e.g., failure to complete training, etc., the Examiner respectfully disagrees. Bonnstetter discloses a principle purpose of the invention is to fulfill the need for "... a method which allows an employer to identify employees who are masking their natural behavior in their job, who are unmotivated, or who may be considering a career change or employment with another

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organization” (Bonnstetter; col. 2 lines 52-57). Based on the level of ordinary skill in the art, it is noted that identifying an employee who is unmotivated in a job suggests identifying a person who may not succeed (or would fail) at a particular job.

Furthermore, the Examiner respectfully submits that Bonnstetter’s disclosure of a questionnaire for determining whether a person will be successful at a job, wherein the questionnaire determines whether a person will follow policy while on the job, wherein a scale is used in a report, wherein the report has a 1-10 scale, wherein 10 indicates perfect for a particular factor such as will a person follow policy (Fig. 7L, col. 2 lines 34-41, col. 9 lines 9-56). It is the position of the Examiner that based on the knowledge of ordinary skill in the art, the skilled artisan would understand that a score of zero would mean a potential job applicant would not be likely to follow policy on a job (i.e., failure). Therefore, it is respectfully submitted that Bonnstetter suggests predicting success or “failure”, and thus the combination of Bonnstetter with Peters and Sarchione is proper. In addition, Applicant states that the term “event” should be given its plain meaning, and thus Bonnstetter’s disclosure of “an ability to follow policy” in Figure 7L, provides a suggestion of “an event.”

In response to the Applicant’s assertions that the word “event”, “outcome”, and “occurrence” are never used by Bonnstetter, and in addition, the Applicant argues that the Examiner improperly equates Applicant’s life history information with Bonnstetter’s behavioral and value characteristics, firstly, the Examiner notes that Applicant’s claims do not recite “occurrence.” Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re*

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Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Secondly, Bonnstetter was never relied upon for teaching an “event” and “outcome”. It is respectfully submitted Sarchione was relied upon for teaching an “event” and “outcome”. Sarchione discloses using personality and life history information to predict dysfunctional job behavior (reads on “predefined negative outcome”) in the law enforcement occupation, wherein the dysfunctional job behaviors encompass a wide variety of undesirable actions such as absence, theft, and drug use, sexual misconduct, insubordination, and inappropriate verbal conduct toward the public (reads on “predefined negative outcome”), wherein the life history information was obtained from personal history questionnaires, a structured interview, and/or a background investigation report and including information related to work history, criminal history, and drug use history (reads on “life history information comprises more than one life event”), and wherein life history indices were predictive of job behavior as individuals who engaged in behaviors such as marijuana use, military court martial, and conviction for driving under the influence of alcohol (reads on “negative indicator” and “critical item”) had a much higher probability of subsequent disciplinary problems (reads on “predefined negative outcome”) as law enforcement officers than their counterparts who did not engage in such behaviors (page 905 col. 1 par. 2 and col. 2 par. 1-2; page 906 col. 1 par. 1 and col. 2 par. 2-4; Table 1 page 907; page 910 col. 1 all; page 911 col. 1 all). Thus, it is the position of the Examiner that Bonnstetter’s method for predicting whether or not an employee will succeed at a job by presenting to the individual selected questions related to behavior and value characteristics relevant to the job (col. 26 lines 37-41),

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keying in responses to a computer for the selected questions and storing the answers on a computer disc in a computer (col. 4 line 63 to col. 5 line 2, col. 5 lines 29-42, and col. 6 lines 31-36), identifying specific factors required to be successful for a particular job at a particular company (col. 2 lines 36-40), and analyzing and predicting the individuals success for a particular job (col. 2 lines 13-37 and col. 28 lines 11-15) taken in combination with Sarchione's teachings discussed above, and the teachings of Peters would put the skilled artisan in possession of Applicant's invention. Furthermore, in response to Applicant's assertions that the Examiner equates Applicant's life history information with Bonnstetter's behavioral and value characteristics, the Examiner disagrees as the Examiner did not rely upon Bonnstetter for teaching life history information, and thus these statements are improper.

(D) At pages 10-11 of the 10 July 2003 response, Applicant argues that Peters et al. has nothing to do with acquiring information for use in making employment decisions, and thus, is simply not relevant to the present invention. In addition, Applicant states that the Examiner has not articulated how or why Bonnstetter and Peters et al. can be combined. Further, Applicant argues that the combination of Bonnstetter and Peters is improper because the objectives of Peters are different than the Applicant's objectives for his invention.

In response to Applicant's assertions regarding the Peter's references not being relevant to the present invention, the Examiner respectfully submits that these statements are misdescriptive of the full teachings of the Peter's reference. Peter's

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discloses that the invention has wide commercial application for information gathering purposes, and it enables a user to ask any types of questions, any number of questions with any branching complexity, of hundreds or even thousands of users (col. 40 lines 43-53). Thus, it is the position of the Examiner that the Peter's reference is relevant to Applicant's invention because Peters can be applied for any type of question, and thus Peters could include questions pertaining to employment.

In response to Applicant's assertions states that the Examiner has not articulated how or why Bonnsetter and Peters et al. can be combined, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner both in the present Office Action as well as the prior Office Action. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93). In particular, the Examiner explicitly stated a motivation at the last full paragraph of page 5 of the previous Office Action "reducing the amount of time to answer a survey by displaying only questions which are relevant to the user (Peters; col. 6 lines 19-27), reducing the amount of information received from a user (Peters; col.

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1 lines 39-49), therefore reducing the cost and amount of storage needed for the responses, and increasing the accuracy of a prediction of an individuals success for a particular job (Bonnstetter; col. 1 lines 33-36 and col. 2 lines 13-22)" based on the teachings of the applied prior art.

In response to Applicant's assertion that the combination of Bonnstetter and Peters is improper because the objectives of Peters are different than the Applicant's objectives for his invention, the Examiner respectfully submits that the courts have held "The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious." *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985) (The prior art taught combustion fluid analyzers which used labyrinth heaters to maintain the samples at a uniform temperature. Although appellant showed an unexpectedly shorter response time was obtained when a labyrinth heater was employed, the Board held this advantage would flow naturally from following the suggestion of the prior art.).

In addition, the Examiner is concerned that Applicant is analyzing the applied references, namely Bonnstetter taken in combination with Peters, separately and in a vacuum, without considering the knowledge of average skill in the art. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition,

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the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Peters includes obtaining and collating information from a plurality of computer users by asking questions using a survey, wherein the information obtained is added and stored in a database, wherein the survey document includes branched to questions linked to another question or questions such that the branched-to question or questions will only be required to be answered by a respondent user if the respondent user gives a predetermined answer(s) to the question or series of questions to which the branched-to question is linked, wherein the survey document is present to the respondent user as a plurality of screens (where there are a plurality of questions), each screen asking one question and where the screen presenting a branched-to question will not be presented by the display to the remote user unless, he makes one or more predetermined answers to a previous question or questions (col. 1 lines 10-16, col. 3 line 47 to col. 6 line 44, and col. 115 lines 1-23). Thus, it is the position of the Examiner that Bonnstetter's method for predicting whether or not an employee will succeed at a job by presenting to the individual selected questions related to behavior and value characteristics relevant to the job (col. 26 lines 37-41), keying in responses to a computer for the selected questions and storing the answers on a computer disc in a computer (col. 4 line 63 to col. 5 line 2, col. 5 lines 29-42, and col. 6 lines 31-36), identifying specific factors

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required to be successful for a particular job at a particular company (col. 2 lines 36-40), and analyzing and predicting the individuals success for a particular job (col. 2 lines 13-37 and col. 28 lines 11-15) taken in combination with Peter's teachings discussed above and the teachings of Sarchione, would put the skilled artisan in possession of Applicant's invention.

(E) At page 11 of the 10 July 2003 response, Applicant argues that Sarchione does not teach a computer-based system. In addition, Applicant argues Bonnstetter is not combinable with Sarchione because Bonnstetter is directed toward acquiring information used to predict employment success, whereas Sarchione is directed to acquiring information to predict a predefined negative outcome.

In response, the Applicant analyzes the applied references separately. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

The Examiner respectfully submits that Sarchione was not relied upon for teaching a computer-based system. Bonnstetter was relied upon for teaching a computer-based system. See Bonnstetter's disclosure of a method using a computer for predicting the success of an individual for a particular job using measured behavioral and values characteristics of the individual to avoid potentially biasing factors and to have a consistent expert system to allow evaluation of individuals (col. 1 lines 10-15, col. 4 line 63 to col. 5 line 2) comprising:

(a) presenting to the individual selected questions related to behavior and value characteristics relevant to the job (col. 26 lines 37-41);

(b) keying in responses to a computer for the selected questions and storing the answers on a computer disc in a computer (col. 4 line 63 to col. 5 line 2, col. 5 lines 29-42, and col. 6 lines 31-36);

(c) identifying specific factors required to be successful for a particular job at a particular company (col. 2 lines 36-40); and

(d) analyzing and predicting the individuals success for a particular job (col. 2 lines 13-37 and col. 28 lines 11-15).

Thus, it is the position of the Examiner that Bonnstetter's method taken in combination with Sarchione's disclosure of personality and life history information to predict dysfunctional job behavior (reads on "predefined negative outcome") in the law enforcement occupation, wherein the dysfunctional job behaviors encompass a wide variety of undesirable actions such as absence, theft, and drug use, sexual misconduct, insubordination, and inappropriate verbal conduct toward the public (reads on

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"predefined negative outcome"), wherein the life history information was obtained from personal history questionnaires, a structured interview, and/or a background investigation report and including information related to work history, criminal history, and drug use history (reads on "life history information comprises more than one life event"), and wherein life history indices were predictive of job behavior as individuals who engaged in behaviors such as marijuana use, military court martial, and conviction for driving under the influence of alcohol (reads on "negative indicator" and "critical item") had a much higher probability of subsequent disciplinary problems (reads on "predefined negative outcome") as law enforcement officers than their counterparts who did not engage in such behaviors (page 905 col. 1 par. 2 and col. 2 par. 1-2; page 906 col. 1 par. 1 and col. 2 par. 2-4; Table 1 page 907; page 910 col. 1 all; page 911 col. 1 all) would put the skilled artisan in possession of Applicant's invention at the time the invention was made.

In response to Applicant's assertion that Bonnstetter is not combinable with Sarchione because Bonnstetter is directed toward acquiring information used to predict employment success, whereas Sarchione is directed to acquiring information to predict a predefined negative outcome. The Examiner respectfully submits that Bonnstetter's disclosure of a questionnaire for determining whether a person will be successful at a job, wherein the questionnaire determines whether a person will follow policy while on the job, wherein a scale is used in a report, wherein the report has a 1-10 scale, wherein 10 indicates perfect for a particular factor such as will a person follow policy (Fig. 7L, col. 2 lines 34-41, col. 9 lines 9-56). It is the position of the Examiner that

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based on the knowledge of ordinary skill in the art, the skilled artisan would understand that a score of zero would mean a potential job applicant would not be likely to follow policy on a job (i.e., failure). Therefore, it is respectfully submitted that Bonnstetter suggests predicting success or "failure", and thus the combination of Bonnstetter with Peters and Sarchione is proper.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-

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3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

14. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-8374 [Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor (Receptionist).

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September 10, 2003

Joseph Thomas
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